

REMARKS

Claims 1-18 were pending in the application. Claims 1-18 have been variously rejected under 35 U.S.C. § 102 and §103. Claims 1-18 have herein been canceled without prejudice. Applicant reserves the right to reintroduce the subject matter of claims 1-18 in a subsequent action.

Applicant has herein added the new claims 19-69 to clarify the three-party nature of the present invention. No new matter has been added. Support for the new claims may be found throughout the present invention.

For at least the reasons stated herein, Applicant respectfully traverses the rejections, and asserts that all claims are now in condition for allowance.

The cited references

Abgrall generally teaches a method of displaying an image during boot-up and shutdown in a computer system. An image having an image format compatible with the operating system is obtained and the content of a system file corresponding to the transition of the operating system is created using the image in a system directory.

Gerace generally discloses a computer network method targeting an appropriate audience based on psychographic or behavioral profiles of end users. The psychographic profile is formed by recording computer activity and viewing habits of the end user. Content categories of interest and display format in each category are revealed by the psychographic profile, based on user viewing of aggregate information. Using the profile, advertisements are displayed to appropriately selected users. Based on regression analysis of recorded responses of a first set of users viewing the advertisements, the target user profile is refined. Viewing by and regression analysis of recorded responses of subsequent sets of users continually auto-targets and customizes ads for the optimal end user audience.

The cited references distinguished

The present invention as claimed by the new claims 19-69 teaches a system and method

for a first business entity to provide installation management in a network-based supply chain framework between at least two other independent business entities such as service providers, vendors, resellers, manufacturers and the like, as claimed by the new claims 19-69 of the present invention.

35 U.S.C. § 102 Rejections

Claims 1-3, 5-9, 11-15 and 17-18 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Abgrall (US Patent 6,373,498). Abgrall does not teach a three-party system, thus the § 102 rejection should not apply to claims 19-69. Since applicant has canceled claims 1-18, the §102 rejections based on Abgrall are moot at this point. Applicant asserts that not every element of every claim, as amended, is taught by the reference. MPEP § 2131 provides:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim...”

With respect to new claims 19-69, the invention has been clarified to claim the invention as a three-party system.

35 U.S.C. § 103 (a) Rejections

It has been further been asserted that claims 4, 10 and 16 are unpatentable under 35 U.S.C. § 103, over Abgrall, in view of Gerace (US. 5,991,735). Applicant respectfully traverses to these rejections.

Applicant maintains that claims 4, 10 and 16 are were not taught or suggested by cited references and were in a condition for allowance in their original form. However, the dependent claims 4, 10 and 16 are herein withdrawn from consideration by the Applicant, thus making the §103 rejections moot at this time.

Furthermore, newly added claims 19-69 are introduced to more particularly define and distinguish the present invention over the cited art. Support for the claimed invention may be found throughout the specification. No new matter was introduced herein.

Section 2143 of the MPEP provides in part, "To establish a prima facie case of obviousness...the prior art reference...must teach or suggest all the claim limitations." (emphasis added). The recent decision of the U.S. Court of Appeals Federal Circuit of In Re Lee, 61 USPQ2d 1430, is particularly pertinent to this issue. At page 1433, the Court addresses the purpose of the Administrative Procedure Act which requires administrative agencies, including the Patent Office, to not only have reached a sound decision, but to have articulated the reasons for that decision. This applies to patent prosecution in the Office and before the Board and subsequent review. In addressing the issue of obviousness the Court noted that rejections under 35 USC § 103 must be based on evidence comprehended by language of the Section. The Court cites a series of cases requiring the showing of a suggestion, teaching or motivation to combine prior art references as an essential component to an obviousness holding. The Patent Office Board of Appeals in the Lee matter had rejected the need for any specific hint or suggestion in a particular reference to support the combination of prior art teachings. The Board had relied upon basic knowledge or common sense. In essence, the CAFC required that there be evidence of the showing of a suggestion, teaching or motivation to combine the state of the art including what might be considered basic knowledge or common sense to combine or modify references with respect to the claims 19-69. Because the cited references alone or in combination fail to teach or suggest all of the claim limitations especially with respect to claims 19-69 directed to a three-party system, Applicant respectfully requests that the Examiner's § 103 rejections do not apply to the new claims 19-69.

Abgrall does not teach or disclose a system or method *for a first business entity to provide installation management in a network-based supply chain framework between at least two other independent business entities such as service providers, vendors, resellers, manufacturers and the like*, as claimed by the new claims 19-69 of the present invention.

Because not every element of every claim, both existing and newly added is taught by the reference, the Examiner's § 102 rejections are not supported by the art and Applicant respectfully requests that the §102 rejections be withdrawn.

Furthermore, Abgrall, in view of Gerace does not teach or suggest a system or method *for a first business entity to provide installation management in a network-based supply chain framework between at least two other independent business entities such as service providers, vendors, resellers, manufacturers and the like*, as claimed by the new claims 19-69 of the present invention. Therefore, the new claims 19-69 are patentable in view of the cited references.

CONCLUSION

Applicant's submit that pending claims 19-69 are allowable and respectfully requests that a Notice of Allowance be issued in this case. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (650) 320-4358. If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees including fees for any extension of time, to Deposit Account No. 02-3964 (Reference 60021-334801).

Respectfully submitted,



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CERTIFICATE OF MAILING (37 CFR 1.8(a))

I hereby certify that this paper (along with any attachments referred to as being enclosed) is being deposited with the United States Postal Service with sufficient postage as first class mail in the envelope addressed to: Box Fee Amendment, Commissioner of Patents, Washington D.C. 20231.

Dated: March 17, 2003

By:

Yvette Yturralde-Owen

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Title

Please amend the title: ~~SYSTEM, METHOD AND ARTICLE OF MANUFACTURE FOR ENHANCED VISIBILITY DURING INSTALLATION MANAGEMENT IN A NETWORK-BASED SUPPLY CHAIN ENVIRONMENT.~~